

REMARKS

Summary of the Amendment

Upon entry of the present Amendment, Claims 22 and 23 will have been cancelled without prejudice or disclaimer, Claims 1921 will have been amended, and new Claim 24 will have been added. Furthermore, the Drawings (sheets 1 and 4-8) and the specification (paragraphs [0003-0004], [0007-0008], [0012] and [0033-0034] will have been amended.

Proposed Amendment to the Drawings

Replacements Sheets 1 (of 8) and 4-8 (of 8) for proposed amendments to Figures 1 and 5-11 have been submitted for consideration.

Figures 5-9 are all discussed in the Description of Related Art section of the specification as conventional art references, therefore, a "Prior Art" label has been added to those figures.

Further, as requested by the Examiner (see Objection to the Drawings below), Applicant has amended Figures 1, 5 and 10-11 to reflect the Examiner's request (see Replacement Sheets 1, 4 and 7-8) to label the boxes identified by reference numerals 10, 11 in Figures 1 and 10-11, and 110, 111 in Figure 5.

Moreover, the apparatus is now identified as "X" in Figure 1 and as "A" in Figure 5. Also the photodetector in Figs. 6 and 8 is now identified by reference numeral 108.

Accordingly, Applicant respectfully requests the Examiner to indicate approval of the aforementioned amendments shown in Replacement Sheets 1 (of 8) and 4-8 (of 8) for Figures 1 and 5 through 11.

Traversal to the Objection to the Drawings

The drawings are objected to because there are no labels for each block of Figures 1-11. The Examiner contends that these Figures need to have descriptive labels under CFR 1.84(n) and 1.84(o). Then the Examiner submits that, for example, in Figure 1, reference number 6 should be labeled as a photodetector.

To further understand the aforementioned objection to the drawings, Applicant discussed the same over the telephone with Examiner Abdin. In particular, the Examiner requested that reference numerals 10, 11 in Figures 1 and 10-11, and 110, 111 in Figure 5 be labeled. Further, the Examiner request that the Figures discussed in the Background of the Specification be labeled as "Prior Art".

Applicant respectfully traverses the Examiner's request to label reference numerals 10, 11 in Figures 1 and 10-11, and 110, 111 in Figure 5. In particular, Applicant is of the opinion that since Figures 1, 5 and 10-11 are representative of an apparatus (as compared to method, flow diagram or box-type diagram) in which so-called "labeling" is typically not required. Moreover, it is impossible to add labels inside the boxes as the Examiner requests. However, in an effort to expedite prosecution, Applicant has amended Figures 1, 5 and 10-11 to reflect the Examiner's request discussed over the telephone (see Replacement Sheets 1, 4 and 7-8).

Moreover, Applicant has provided Replacement Sheets 4-6 to add the "Prior Art Label" to Figures 5 through 9 as requested by the Examiner.

Accordingly, Applicant respectfully requests the Examiner to indicate approval of the aforementioned amendments to Figures 1 and 5-11 in the next Official Office Action.

Amendments to the Specification

Various amendments have been made to the specification (paragraphs [0003-0004], [0007-0008], [0012] and [0033-0034] to improve the overall form of the specification. In particular, description of features of the conventional art and of the present invention which were illustrated in the drawings, but inadvertently not discussed in the specification, was added to the aforementioned paragraphs. *It is believed that no new matter has been added to the specification.*

Traversal of Rejection under 35 U.S.C. § 112-2

Claim 23 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 23 has been cancelled and therefore the aforementioned rejection is rendered moot.

Traversal of Rejection under 35 U.S.C. § 102(b)

Applicant traverses the rejection of Claims 19-23 under 35 U.S.C. § 102(b) as being anticipated by JP Publication No. 09-181340 to TATEKI.

In particular, the Examiner contends that Figures 13 and 32 of TATEKI discloses an optical device (Fig. 32) comprising a light-emitting element (laser diode) for converting an electronic signal to an optical signal ([0003], lines 1-4); a light-receiving element for signal detection (9, photodetector) for converting a received optical signal to an electronic signal ([0006], lines 3-6, Fig. 32; at least two light-receiving elements (7, 9, photodetector) for position detection for detecting a receiving position of a luminous flux emitted from a light-emitting element of an opposed partner device (LB) by means of plural light-receiving units divided by separating (s band, [0022] and Fig. 6), a mirror (4a, adjustable mirror) adjusted so as to align an optical axis of the luminous fluxes emitted from said light-emitting element of said optical transmission device in accordance with the detected position by the light-receiving elements for position detection, wherein said at least two light-receiving elements for position detection (7, 9, photodetector) are arranged so that receiving positions of said light-receiving elements are farther than the width of said separating bands each other ([0022], [0006], Figs. 6-7 and 32).

Applicant respectfully disagrees.

To anticipate a claim, the reference must teach each and every element of the claim

Applicant notes that anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. See *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1570, 7 USPQ2d 1057, 1064 (Fed. Cir. 1988) cert denied, 488 U.S. 892 (1988); *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984), cert. dismissed sub nom.; *Hazeltine Corp. v. RCA.*, 468 U.S. 122 (1984). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a

single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant submits that TATEKI does not teach each and every element recited in Claims 19-21 and 24.

Independent Claim 19:

As amended, base Claim 1 now recites, *inter alia*, at least two other light-receiving photodetectors for position detection, each photodetector including a plurality of light receiving elements separated by a separating band having a width L, for detecting a receiving position of a luminous flux emitted from an other light-emitting element from an opposed partner device, wherein each of the other light-receiving photodetectors are separate and independent from the first light-receiving photodetector; and wherein said at least two other light-receiving photodetectors for position detection are arranged so that receiving positions of said at least two light-receiving photodetectors are shifted a distance D which is greater than the width L of the separating band with respect to a plane perpendicular to the optical axis of the optical transmission device. Applicant respectfully submits that TATEKI fails to disclose at least the above-noted features of the present invention.

As best understood, Figure 32 of TATEKI only teaches the use of two light receiving elements, in particular, a "main signal detector light sensor 7" and a "position detection light sensor 9". On the other hand, the present invention teaches the use of at least three light-receiving photodetectors 6, 8a and 8b. Moreover, the manner in which Applicant originally presented Claim 19 made it clear that two of the light-receiving photodetectors where for position detection purposes (and now it is even more clear in the amended form). Further, the Examiner's rejection appears to be clearly in error by considering the TATEKI main signal detector light sensor 7 to satisfy Claim 19's requirement that there be at least two light-receiving elements for position detection.

Moreover, the Examiner overlooks the notion that the TATEKI reference appears to not teach, *inter alia*, . . . wherein said at least two other light-receiving photodetectors

for position detection are arranged so that receiving positions of said at least two light-receiving photodetectors are shifted a distance D which is greater than the width L of the separating band with respect to a plane perpendicular to the optical axis of the optical transmission device. That is to say, contrary to the Examiner's assertion, TATEKI does not disclose in paragraph [0006] and [0022] that the location gap between a receiving position of said photo detector 9 and a receiving position of said photodetector 7 and 22 is larger than the width of a separator 22b. Rather, according to TATEKI, adjustment is made so as to fill the location gap between the receiving position of said photodetector 9 and the receiving position of said photodetector 7 and 22 as described in paragraph [0006] of TATEKI.

For the foregoing reasons, TATEKI fails to disclose the above-noted features of the present invention. Therefore, Applicant submits that TATEKI fails to disclose each and every feature of the present invention as now recited in amended base Claim 19.

Accordingly, Applicant submits that the Examiner has failed to establish an adequate evidentiary basis to support a rejection under 35 U.S.C. § 102(b) and that the rejection of base Claim 19 is improper and should be withdrawn.

Dependent Claims 20-21:

Applicant further submits that dependent Claim 20-21 are allowable at least for the reason that these Claims depend from allowable independent Claim 19 and further recite additional features that further define the present invention.

Accordingly, Applicant submits that the Examiner has failed to establish an adequate evidentiary basis to support a rejection of dependent Claims 20-21 under 35 U.S.C. § 102(b) and that the rejection of these claims is improper and should be withdrawn.

New Dependent Claim 24 is Allowable

Applicant further submits that new dependent Claims 24 is also allowable at least for the reason that Claim 24 depends from allowable independent Claim 19 and further recites additional features that further define the present invention.

Application is Allowable

Applicant respectfully submits that each and every pending claim of the present invention meets the requirements for patentability and respectfully requests the Examiner to indicate allowance of each and every pending claim of the present invention.

CONCLUSION

Applicant respectfully submits that each and every pending claim of the present application meets the requirements for patentability under 35 U.S.C. §§ 112, 101, 102 and 103, and respectfully requests that the Examiner indicate the allowance of such claims.

Further, any amendments to the claims which have been made in this response and which have not been specifically noted to overcome a rejection based on the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

If any additional fee is require, please charge Deposit Account No. 502456.

Should there be any questions or comments, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,

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